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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Michael Berthon-Jones

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EXAMINER

JACKSON, BRANDON LEE

ART UNIT

PAPER NUMBER

3772

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/523,607	Applicant(s) BERTHON-JONES ET AL.	
	Examiner BRANDON JACKSON	Art Unit 3772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/3/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to amendments/arguments filed 7/23/2010.
Currently, claims 24-51 are pending in the instant application.

Response to Arguments

Applicant's arguments, see Page 1, filed 7/23/2010, with respect to the rejection(s) of claim(s) 24 under 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Gradon et al. *U.S. Patent 6,615,834*.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 24-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gradon et al. *U.S. Patent 6,615,834* in view of Garelick *U.S. Patent 2,823,671*.

With respect to claims 24 and 38, Gradon discloses a mask (2) for use with a CPAP device (col. 2, lines 57-58) comprising a frame (102) and a cushion (104) attached to the frame (102). The cushion (104) contacts the user's (1) face (fig. 4) and provides an opening for the passage of pressurized gas from the CPAP machine to the user (1). Gradon fails to describe the cross sectional configuration of the cushion. However, Garelick discloses a mask comprising a frame (10), a cushion (40) attached to the frame (10) and having a U-shaped cross-section (fig. 1) defining a face contacting surface. The cushion (40) includes an inner leg of the U-shaped configuration (fig. 1) that is proximal the frame at one end (11), and an outer leg (47) of the U-shaped configuration (fig. 1) spaced away from the frame (10). The inner leg (fig. 1) extends in a continuous, uninterrupted and smooth manner (figs. 1-6). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to replace the Gradon cushion to have a same cross-sectional configuration, as taught by Garelick, in order to comfortably seal the mask to the user's face.

With respect to claim 25, Gradon discloses the frame (102) includes an inner peripheral portion (fig. 4) that is connected to the cushion (104).

With respect to claims 26-27 and 42-43, Garelick teaches the cushion is made of flexible, resilient material, such as rubber or the like. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Garelick cushion to comprise a foam cushion or a silicon material, since it has been

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held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

With respect to claim 28, Garelick teaches the cushion (40) curves away (fig. 7) from the frame (10) and forms a face contacting surface (40).

With respect to claim 29, Garelick teaches the inner (fig. 1) and outer (47) legs a generally mirror images of one another.

With respect to claims 30 and 44, Garelick teaches the outer leg (47) curves outwardly (fig. 7) compared to the frame (10) such that the free end portion thereof is directed away from a patient side (40) of the mask is substantially parallel (fig. 1) to the inner leg (fig. 1)

With respect to claims 31 and 45, Garelick teaches the U-shaped configuration (fig. 1) defines a recess (45) defining a space between the inner (fig. 1) and outer (47) legs.

With respect to claims 32 and 46, Garelick teaches the face contacting surface (40) includes a generally convex (fig. 7) and adapted to contact the user's face (col. 3, lines 25-30).

With respect to claims 33 and 47, Garelick teaches the inner leg (fig. 1) extends to the flow opening of the frame (10).

With respect to claims 34 and 48, Garelick teaches the inner leg (fig. 1) has a convex shape.

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With respect to claims 35 and 49, Garelick teaches the cushion extending from the outer leg (47) across the connecting portion (46) and to the inner leg (fig. 1) has a generally convex shape when viewed from inside the perimeter of the cushion (40).

With respect to claims 36-37 and 50-51, Gradon discloses headgear connectors (120, 122, 124) that are connected to the headgear (108) that is secured to the patient's (1) head (fig. 4).

With respect to claim 39, Gradon discloses a supporting portion (102) adapted to support (fig. 4) a cushion (104).

With respect to claim 40, Gradon discloses a tube portion (103) connected to an opening in the supporting portion (102).

With respect to claim 41, the tube portion (103) is adapted to connect to a pressurized gas conduit (fig. 3).

Conclusion

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRANDON JACKSON whose telephone number is (571)272-3414. The examiner can normally be reached on Monday - Friday 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on (571)272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brandon Jackson/
Examiner, Art Unit 3772

/BLJ/

/Patricia Bianco/

Supervisory Patent Examiner, Art Unit 3772